

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

<b>Appl. No.</b>	: 10/591,930	<b>Confirmation No.:</b>	4599
<b>Applicant (s)</b>	: Michael Vernon Spencer	<b>TC/A.U.</b>	: 1654
<b>Filed</b>	: September 07, 2006	<b>Examiner</b>	: R.T. Niebauer
<b>Title</b>	: Production of Low Molecular Weight Ethylcellulose		
<b>Docket No.</b>	: 63669A		
<b>Customer No.</b>	: 00109		
<b>Appeal No.</b>	: 2010-004978		

### **REQUEST FOR REHEARING**

Further to the Decision on Appeal dated Nov. 10, 2010, Applicants request a rehearing pursuant to 37 CFR 41.52. The point believed to have been misapprehended or overlooked by the Board is that the Board erred by relying on the *absence of an element from a "comprising" language claim* as evidence of an alternative embodiment, and then using this to contradict actual teachings of a reference.

Note that Applicants do not dispute that the Findings of Fact (FF) with respect to US Pat. No. 6,261,218 to Schultz, namely, FF2 and FF3 are independently accurate. However, as a matter of law, FF3 is irrelevant and its use to contradict FF2 is improper. To elaborate on this error:

- Both Schultz (FF2) and the Applicants (Independent Claims 1 & 8) teach acid being added to depolymerize a cellulose ether (obviously, therefore, those skilled in the art can be presumed to know acid will always be present).
- As acknowledged in FF2, Schultz adds base "to partially or substantially neutralize any<sup>1</sup> remaining acid." Schultz's example used a stoichiometric amount of base to neutralize the acid, thereby substantially neutralizing any remaining acid. *See id.* col. 7, lines 3-5. Accordingly, there is no teaching in Schultz that neutralization is optional, it requires at least *some* level of neutralization.
- Nevertheless, in FF3, the Board finds that Shultz's Claim 1 does not specifically *claim* a neutralization step. While true, this is irrelevant. ***Under US law, no conclusion can be drawn regarding an omission of an element from a "comprising" claim.*** *Inter alia*, MPEP 2111.03 explains that "The transitional term "comprising", which is

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<sup>1</sup> Taken in context, the common English construction of "any remaining" refers back to "substantially," not whether acid is present, because if depolymerization was undertaken, acid is present (see first bullet).

synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and ***does not exclude*** additional, unrecited elements or method steps. *See, e.g., ... < Invitrogen Corp. v. Biocrest Mfg., L.P.*, 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003) ("The transition 'comprising' in a method claim indicates that the claim is open-ended and **allows for additional steps.**"); *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and *still form a construct within the scope of the claim.*). Emphasis added.

- Accordingly, the Board erred on page 7, lines 6-8, of the Decision on Appeal where it stated:

... The Examiner buttressed this finding<sup>2</sup> by pointing to claim 1 of the Shultz patent which is drawn to a depolymerization process which omits the acid neutralization step ...

Emphasis added. ***Clearly, the Board's inference of exclusion or omission of a step by its absence in a "comprising" claim is unsupportable under Office practice and US law.***

Since this is a point that has obviously been misapprehended by the Board, and was used to support affirmation of both rejections, Applicants feel that the Board should reconsider whether the Examiner has even established a *prima facie* case<sup>2</sup> for the rejections. To Applicants' minds, there is no evidence to suggest the limitation of "without a neutralization step after depolymerization" (Independent Claims 1 & 8).

The Director is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 041512.

Respectfully submitted,

January 7, 2011

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<sup>2</sup> The "critical step" thesis in the sentence preceding the above in the Decision is at least unconvincing. Rather than draw the inference that neutralization was *not* a critical step, the absence from the claim could easily be explained under Office practice because *neutralization was so uniformly accepted as a given by those skilled in the art that Schultz need not have affirmatively recited neutralization, e.g., "Claims are not rejected as broader than the enabling disclosure under 35 U.S.C. 112 for noninclusion of limitations dealing with factors which must be presumed to be within the level of ordinary skill in the art."* MPEP 2164.08.